

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#21
6/16/04
mel

In re Application of : Herzberg et al.

Serial No. : 09/625,006

Group Art Unit: 3621

Filed : July 25, 2000

Examiner: Kambiz Abdi

For : MICRO PAYMENT-BASED ADVERTISING

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RECEIVED
JUN 10 2004

REPLY BRIEF

GROUP 3000

In response to the Examiner's Answer, dated April 6, 2004, Appellant respectfully submits the following remarks.

(1) Clarification of the points at issue

The claims in the present patent application recite methods, apparatus and software for electronic advertising and electronic commerce that involve three types of parties: a merchant, advertisers and a buyer. As stated in the Appeal Brief (page 2, lines 13-14), the claimed invention is directed specifically to compensating advertisers for their sales of an item that they offer on behalf of a merchant on a "page per fee" basis. This object is accomplished by using multiple aliases to represent the network address of the item, i.e., multiple aliases represent the same actual address. The merchant assigns a different, respective alias to each advertiser. The alias is included in orders that reach the merchant as a result of advertising, and thus specifically identifies the advertiser for purposes of compensation. Appellant has pointed out repeatedly in the amendments and Appeal Brief filed in this case that the prior art does not teach or suggest this use of specific, different aliases for different advertisers. This is the key point at issue in the current appeal.

In the above-mentioned Answer (page 13, first paragraph), the Examiner frames the issue in a different manner, which has no support in the Appeal Brief:

Reply Brief in re: Herzberg et al.

U.S. Pat. App. Ser. No. 09/625,006

“Examiner would like to point out that what the alleged inventive step of the claim by the appellant is the URL linking the user to the item at the merchant’s site in addition to the calculations of transactions and purchasing of the item on the micro-payment bases and that is what best understood by the examiner of the alleged inventive steps of the claims 1, 24 and 30.”

This supposed summary of the claimed invention takes in any and all Web-based commerce using micro-payments, even without involvement of advertisers or aliases. It grossly misstates the essence of the present invention, in a manner that has no support either in the claim language or in papers that Appellant has submitted in this case. Many of the Examiner’s arguments appear to relate to this misconception of the claims, rather than to the claims themselves.

(2) Examiner has overstated the use of aliases in the cited art

All the claims in the present patent application were rejected under 35 U.S.C. 103(a) over Messer (U.S. 5,991,740) in view of Barber (U.S. 6,157,917).

With regard to Barber, the Examiner states in the Answer (page 13, lines 17-18): “Appellant’s assertion that Barber does not show an alias for the link directing the payer (user) to the payee (merchant) is in error.” Appellant has made no such assertion, but actually conceded the contrary (page 6, lines 13-16 in the Appeal Brief): “Barber shows a list of typical aliases in Table 2.” The Examiner has misrepresented Appellant’s arguments and has thus devoted much of the Answer to rebutting contentions that Appellant has not made.

Rather, as stated in the Appeal Brief, Messer does not disclose the use of aliases. The Examiner himself conceded this point (in paragraph 9 of the Official Action of September 9, 2003). Therefore, the Examiner’s argument (last sentence of page 12 in the Answer) that “Messer clearly is aware of the need of not disclosing the final merchant URL to the user and in a manner using banner (ID) and other embedded codes to obfuscate the link,” is puzzling. In support of this statement, the Examiner cites col. 8, lines 52-68, in Messer, which describes (in lines 61-64) the opposite of what the Examiner has asserted: “Immediately thereafter the Clearinghouse server places onto the

Reply Brief in re: Herzberg et al.

U.S. Pat. App. Ser. No. 09/625,006

USER command-line, the address for the Merchant (HTTP)...," i.e., the actual address of the merchant, rather than an alias, is revealed to the buyer (USER).

Returning to Barber and to the last paragraph on page 13 of the Answer, the Examiner again misrepresents Appellant's argument: "Appellant on page 7, section A of the Appeals Brief contested that the Barber reference does not teach or suggest the use of its system in the context of advertising." Appellant has made no such general statement and does not deny that Barber describes the well-known practice of crediting re-sellers for referrals (as in col. 5, lines 25-28). Rather, paragraph A on page 7 of the Appeal Brief states specifically: "Barber neither teaches nor suggests the use of aliases in the context of advertising" (emphasis added). Barber describes the use of aliases only in one limited aspect of the operation of an acquirer, whose role is not to advertise, but rather to process accounting information and collect payments (as explained on page 6, lines 10-27, of the Appeal Brief). Barber's acquirer and re-seller are different entities with distinct purposes. Barber neither teaches nor suggests assigning aliases to re-sellers.

(3) The prior art does not teach or suggest the use of multiple aliases for a single network address

In the final analysis, the Examiner has failed to point out any specific reference in the prior art that discloses the use of multiple aliases to represent the same network address. Barber's Table 2 shows multiple aliases, but only a single alias is assigned to each URL (target address) in the table. The Examiner states in response to this point (on page 14, first paragraph, in the Answer):

"...by using payees identification in the alias link 'AcquirerWebsite/link?payee-980234&link=picture3' makes the alias unique and it would represent the same network address but from different advertiser sites" (emphasis added by Examiner).

This statement, which evidently refers to col. 8, lines 14-22, in Barber, is oddly correct, and supports Appellant's argument. Barber's payee, identified in the above alias, is an information supplier (see abstract), analogous to the merchant recited in the claims of

Reply Brief in re: Herzberg et al.

U.S. Pat. App. Ser. No. 09/625,006

the present patent application. The embodiments described by Barber may involve multiple acquirers (payment collectors), but logically, no more than a single payee offers any given content page – and thus using the payee identification in the alias creates no more than a single alias per address. There is no basis in Barber for the Examiner's reading of "advertiser sites" into the passage cited above, but if there were, the Examiner would be correct in inferring that the same page, belonging to the same payee, would have the same alias on all the different advertisers' sites..

(4) The prior art does not teach or suggest the use of different aliases to identify different advertisers

As pointed out in the Appeal Brief (page 8, paragraph C), even if an acquirer were considered somehow analogous to an advertiser, Barber still does not suggest the use of different aliases for different acquirers. In response to this point, the Examiner simply asserts (page 14, second paragraph): "It is clear that a referral payment is due if the payment transaction is the result of a referral, this referral has to be identified by the issuer, therefore this identification results as well with an alias which would be unique to that of referral party." The Examiner cites no particular support for this statement in the prior art, and in fact, the statement is unsupported, except possibly by hindsight from the present patent application.

(5) Conclusion

As illustrated by the points stated above, the Examiner's Answer to the arguments made by Appellant in the Appeal Brief is based on misrepresentation of Appellant's arguments and on incorrect, unsupported assertions as to the content of the prior art. The Examiner has failed to refute any of the points made in the Appeal Brief.

Although Appellant's arguments in this Response have focused on certain general points, which are common to all the claims pending in this application, Appellant continues to maintain that each of the three groups of claims identified in section (7) of the Appeal Brief is independently patentable. In this regard, Appellant

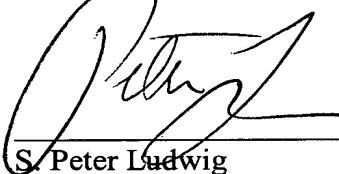
Reply Brief in re: Herzberg et al.

U.S. Pat. App. Ser. No. 09/625,006

calls the attention of the Board to the arguments made on pages 9 and 10 of the Appeal Brief.

For the foregoing reasons, Appellant reiterates that the Examiner's rejection of claims 1-35 was erroneous. Reversal of his decision is respectfully requested.

Respectfully submitted,



S. Peter Ludwig
Registration No. 25,351
Attorney for Applicant

Darby & Darby P.C.
805 Third Avenue
New York, NY 10022
(212) 527-7700

For the foregoing reasons, Appellant reiterates that the Examiner's rejection of claims 1-35 was erroneous. Reversal of his decision is respectfully requested.

Respectfully,

S. Peter Ludwig

Registration No. 25,351
Attorney for Applicant